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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,591	03/07/2002	Raymond J. Bergeron	T2315-907789	9684

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1751 PINNACLE DRIVE
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EXAMINER

COOK, REBECCA

ART UNIT PAPER NUMBER

1614

DATE MAILED: 02/27/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/091,591
Filing Date: March 07, 2002
Appellant(s): BERGERON, RAYMOND J.

Dennis P. Clarke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 27, 2005 appealing from the Office action mailed September 22, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims 1-6 contained in the Appendix to the brief is correct.

(8) Grouping of Claims

Appellant concedes that appealed claims 1-8 stand or fall together. Note that claims 7-8 were cancelled in the After Final Paper of October 14, 2004 and are not copied in the Appendix to the brief. Therefore, claims 1-6 are on appeal.

(9) Evidence Relied Upon

5,962,533

Bergeron

10-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112 Paragraph One

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No support is seen in the specification for the proviso "excluding the trans isomers of the compounds having the structures....." There is nothing in the specification that would lead one to think that the recited compounds can be excluded, such as, *cis* is better than *trans*.

Appellant argues that an appellant is entitled to claim less than the invention contemplated by the original description for whatever reason chosen by that appellant and cites *Johnson* and other decisions. This is not persuasive. The examples in the specification are limited to the compounds excluded by the proviso, which demonstrate that the excluded compounds are the preferred embodiments of the instant invention.

Claim Rejections - 35 USC § 112 Paragraph Two

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The proviso in claim 1 makes the phrase "*trans*...isomer" in claim 2 confusing, since the proviso excludes specific trans isomers.

Appellant argues that since claim 2 is dependent on claim 1, it inherently excludes these two isomers. This is not persuasive. It is not clear that claim 2 excludes the trans (1,4) compounds when x is 3 and 4, which are recited in the proviso of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,962,533. (Bergeron). Bergeron (Table 1, compounds 33 and 34) discloses the compounds differing from the compounds of the compositions of claims 1-6 by a proviso that excludes the trans compound of Bergeron. The instant dependent claims 4-6 differ over Bergeron in reciting a compound in which x and y is 3 as compared to Bergeron where x and y are 4. The instant claims further differ over Bergeron in disclosing a composition suitable for treating diarrhea.

However, in the absence of a showing of unexpected results, no unobviousness is seen in one isomer over the other. In re Adamson et al 125 USPQ 233.

Furthermore, because the characteristics normally possessed by members of a homologous series are principally the same, varying gradually from member to member, one of ordinary skill in the art would know what to expect in adjacent members so that a mere difference in degree is not the marked superiority which will ordinarily remove the unpatentability of adjacent homologues of old substances. In re Henze 85 USPQ 261.

Moreover, Bergeron (column 20, lines 40-45) discloses that the polyamine derivatives of Table 1 were diluted in sterile water, a pharmaceutically acceptable carrier. Thus, Bergeron discloses a composition comprising a compound of claim 8 in a pharmaceutically acceptable carrier.

Applicant argues that the composition of Bergeron is not a "pharmaceutical composition." He further argues that the screening solutions are not enabled as anti-diarrheal compositions since the reference discloses no specific amounts of either compound 33 or 34.

This is not persuasive. There is no evidence on the record to prove that the composition of Bergeron does not necessarily or inherently possess the characteristics of the instant composition. Furthermore, a review of the K_i values for two compounds having anti-diarrheal activity (Figures 8a and 8b; column 17, lines 28-58) when their compositions are administered to test animals discloses the following: DENSPM (compound 11, columns 7-8) has an actual K_i value of 17. DEHSPM (compound 20, columns 7-8) has an actual K_i value of 1.4. The K_i values for compounds 33 and 34 are

Art Unit: 1614

3.5 and 7.9 respectively. This is within the range of values for compounds shown to be effective and would lead one skilled in the art to conclude that compounds 33 and 34 and their homologues would also be effective.

(11) Response to Argument

All issues were fully responded to under the "Grounds of Rejection" portion above.

(12) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

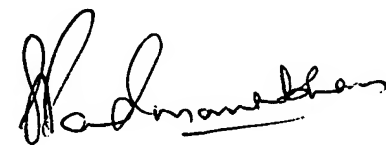
Respectfully submitted,


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February 14, 2006


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